

NATHAN

Serial No. 09/161,584

Amendment in RCE dated October 20, 2003

**REMARKS**

Claims 10-18 are pending in the application. By the present amendment, claim 18 has been added. It is noted that no response was received from the U.S. Patent and Trademark Office to the Request for Reconsideration filed August 14, 2003. Accordingly, the arguments set forth in the August 14, 2003 Request are incorporated in the following remarks. Favorable reconsideration of the application in view of the remarks set forth herein is respectfully requested.

The rejection of claims 10 and 11 under 35 U.S.C. §103(a) over Schotz (U.S. Patent No. 5,832,024) in view of Lee (U.S. Patent No. 5,757,936) is respectfully traversed.

At the outset, it is noted that the combined teachings of Lee and Schotz fail to teach or suggest the specific combination of elements set forth in independent claim 10. While Schotz '570 (not '024) is incorporated by reference in Lee, that disclosure is only in connection with the "transfer process" mentioned at column 2, line 46 of Lee. Lee teaches that the transfer process of Schotz can be used for the amplification of the two (left and right) analog signals and compression of the range (amplitude) of the analog signal, since a limited amplitude or range results in a limited frequency band. In accordance with this aspect of the teachings of Lee, the two analog signals are then transmitted in parallel, on two respective FM carriers. This does not teach or suggest the specific features set forth in claim 10. Moreover, Schotz '024 does not overcome the fundamental deficiencies of Lee. While Schotz '024 does teach the use of quadrature

NATHAN

Serial No. 09/161,584

Amendment in RCE dated October 20, 2003

phase shift-keying from transmitting digital data to loudspeakers, it teaches to transmit the data through air using antennas. Schotz '024 does not teach or suggest using an AC power network for the transmission, much less using the specific elements set forth in claim 10.

It is also important to note that there is no objective motivation to combine Schotz '024 with Lee to arrive at the claimed invention. In particular, Schotz '024 is directed to a system that employs a modulator using Quadrature Phase Shift Keying (QPSK) for transmitting digital data to the loudspeakers. Lee, on the other hand, teaches the use of FM modulation which converts the stereo digital audio signals into two separate FM signals at two different carrier frequencies. It is respectfully submitted that there is no objective motivation in the art to combine features of a system employing QPSK with one that uses FM modulation. These two techniques are entirely inapplicable to one another. As such, one of ordinary skill in the art would not look to FM modulation art to overcome a deficiency in a system employing QPSK, and likewise, one would not look to QPSK art to overcome a problem in an FM modulation system.

It is also respectfully submitted that employing techniques applicable to FM modulation in a QPSK system would destroy the function of the underlying reference. The same is the case when employing techniques applicable to QPSK systems in an FM modulation system – the combination would simply not work.

It is axiomatic that the PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ

NATHAN

Serial No. 09/161,584

Amendment in RCE dated October 20, 2003

785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). This it has not done. The Office Action fails to cite any prior art that overcomes the deficiencies of the base reference or that suggests the obviousness of modifying Schotz '024 to achieve the claimed invention.

Instead, the Office Action improperly relies on hindsight reconstruction of the claimed invention in reaching its obviousness conclusion. "To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Additionally, further evidence of improper hindsight is derived from the absolute impermissible combination of disparate references in the instant rejection. In particular, there is an utter lack of any motivation whatsoever to combine the cited references to achieve the claimed invention. As set forth above, not only is there no motivation to combine the cited references, the proposed combination would destroy the function of the references themselves. Such a combination is *per se* improper.

NATHAN

Serial No. 09/161,584

Amendment in RCE dated October 20, 2003

In view of the foregoing, Applicant respectfully submits that Lee and Schotz '024 fail to establish a *prima facie* case of obviousness for any of the pending claims. Thus, without the improper use of hindsight reconstruction, using the teachings of the instant application, the claims are not rendered obvious under 35 U.S.C. §103. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claims 12, 13, 15 and 16 under 35 U.S.C. §103(a) over Schotz '024 in view of Lee and further in view of Anderson et al. (U.S. Patent No. 5,406,634, hereinafter "Anderson") is respectfully traversed.

It is respectfully submitted that Anderson fails to overcome the fundamental deficiencies noted above with respect to the improper combination of Schotz '024 and Lee. As such, the proposed combination (even if proper, which applicants submit is not the case) of Anderson with the Schotz '024 and Lee nevertheless fails to render the claimed invention obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claim 14 under 35 U.S.C. §103(a) over Schotz '024 in view of Lee and further in view of Brugger (U.S. Patent No. 5,636,276) is respectfully traversed.

It is respectfully submitted that Brugger fails to overcome the fundamental deficiencies noted above with respect to the improper combination of Schotz '024 and Lee. As such, the proposed combination fails to render the claimed invention obvious. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

**NATHAN**

**Serial No. 09/161,584**

Amendment in RCE dated October 20, 2003

In view of the foregoing it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited.

Should the Examiner deem that further issues require resolution prior to allowance, the Examiner is invited to contact the undersigned attorney of record at the telephone number set forth below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:



Updeep S. Gill

Reg. No. 37,334

USG:dbp

1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100